

REMARKS

Claims 1, 3-16, 18-32, and 34-59 are pending. By this amendment, claim 44 is cancelled. No new matter is introduced. Reconsideration and issuance of a Notice of Allowance is respectfully requested.

The formality of the Office Action is improper under MPEP §706.07(a). In particular, the Examiner has provided new grounds for rejecting all the independent claims where the basis for the rejection is not necessitated by the Applicants amendment of the claims. Accordingly, under MPEP §706.07(a) the Office Action should not be final. Applicants respectfully request that the finality of the Office Action be withdrawn as permitted by MPEP §706.07(e).

Assuming the Examiner maintains the finality of the Office Action, Applicants respectfully suggest that entry of the amendments is proper in accordance with 37 C.F.R. §1.116 because the amendments: a) place the application in condition for allowance, and b) do not raise any new issues requiring further search by the Examiner.

On page 2 the Office Action rejects claims 10-13, 15, 20-22, 44, 51-54, and 56 under 35 U.S.C. §112, first paragraph as failing to comply with the written description requirement. This rejection is respectfully traversed. Applicant points out that this application is a division of patent application 07/991,074 filed December 9, 1992 (hereafter the parent application). Considering claims 10-13 and 20-22, which recite limitations of a four wire connector, multipin connector, multipin connector ranging from DB9 to type DB25, and a SCSI connector, all these features can be found in the parent application in at least page 54, lines 1-14, and page 57, lines 14-18. Since these elements are clearly described in the parent application, claims 10-13 and 20-22 meet all the requirements of 35 U.S.C. §112, first paragraph.

Claim 15 recites a limitation of a display that indicates when the hardware upgrade is in use. This feature is fully disclosed in the parent application on page 51, lines 9-13. Hence, claim 15 meets all the requirements of 35 U.S.C. §112, first paragraph.

Claim 44 is cancelled and the rejection of this claim is moot.

Claims 52-54 and 56 recite features of storing digital data including storing digital data on a CD, a CD ROM, a disk and wherein the digital data includes applications stored thereon. These features are fully disclosed in the parent application on page 55, lines 8-19. Hence claims 52-54 and 56 meet all the requirements of 35 U.S.C. §112, first paragraph. Withdrawal of the rejection of claims 10-13, 20-22, 15, 44, 52-54, and 56 under 35 U.S.C. §112, first paragraph is respectfully requested.

On page 3 the Office Action rejects claims 1, 3-9, 14, 16, 18, 19, and 23-29 under 35 U.S.C. §103(a) over U.S. Patent 5,192,999 to Graczyk et al. (hereafter Graczyk) in view of U.S. Patent 5,357,276 to Banker et al. (hereafter Banker), U.S. Patent 5,327,554 to Palazzi et al. (hereafter Palazzi), and U.S. Patent 5,483,277 to Granger (hereafter Granger). This rejection is respectfully traversed.

On page 6 the Office Action admits that Graczyk and Banker are silent on a set top terminal with a hardware upgrade. However, the Office Action asserts that Granger teaches a set top converter that receives a switching module, which is an upgrade module. The Office Action then asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Graczyk and Banker by having an upgrade for set top terminal was taught by Granger.

Granger is not prior art to the present application. Granger was filed December 15, 1992. All the features recited in independent claim 1 are fully disclosed in the parent application, which has a filing date of December 9, 1992, and thus predates Granger. Accordingly, a combination of Graczyk, Banker, Palazzi and Granger cannot render the subject matter of claim 1 obvious. Thus, claim 1 is patentable.

For the same reason as discussed above with respect to claim 1, claims 14 and 24 are also patentable over the combination of Graczyk, Banker, Palazzi and Granger. That is, Granger is not prior art to the subject matter recited in claims 14 and 24, and claims 14 and 24 are patentable.

Claims 3-9 depend from patentable claim 1, claims 16, 18, 19 and 23 depend from patentable claim 14, and claims 25-29 depend from patentable claim 24. For this reason and the additional features they recite, claims 3-9, 16, 18, 19, and 23-29 are also patentable. In view of the above, Applicants respectfully request withdrawal of the rejection of claims 1, 3-9, 14, 16, 18, 19, and 23-29 under 35 U.S.C. §103(a).

On page 9 the Office Action rejects claims 30-42, 45-50, 55, and 58-59 under 35 U.S.C. §103(a) over Palazzi, Banker, Granger, and Graczyk. This rejection is respectfully traversed.

Considering claim 30, as noted above, Granger is not prior art for anything disclosed in the parent application. All the features found in independent claim 30 are fully disclosed in the parent application, and hence claim 30 is not rendered obvious by the combination of Palazzi, Banker, Granger, and Graczyk. Accordingly, claim 30 is patentable. Similarly, independent claim 42 is not rendered obvious by the combination of Palazzi, Banker, Granger, and Graczyk, and hence claim 42 is also patentable. Claims 31-41 depend from

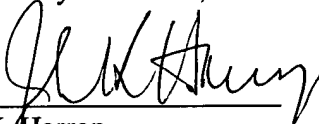
patentable claim 30 and claims 42-50, 55, and 58-59 depend from patentable claim 42, and for this reason and the additional features they recite, claims 31-41, 45-50, 55, and 58-59 are also patentable. Withdrawal of the rejection of claims 30-42, 45-50, 55, and 58-59 under 35 U.S.C. § 103(a) is respectfully requested.

In view of the above remarks, Applicants respectfully submit that the application is in condition for allowance. Prompt examination and allowance are respectfully requested.

Should the Examiner believe that anything further is desired in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicants undersigned representative at the telephone number listed below.

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Respectfully submitted,



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